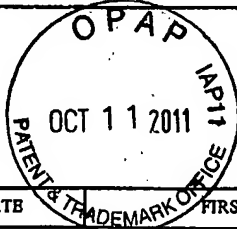




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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/231,970	09/08/2008	Osamu Moriura	F-9835	5248

28107 7590 08/03/2011
JORDAN AND HAMBURG LLP
122 EAST 42ND STREET
SUITE 4000
NEW YORK, NY 10168

EXAMINER

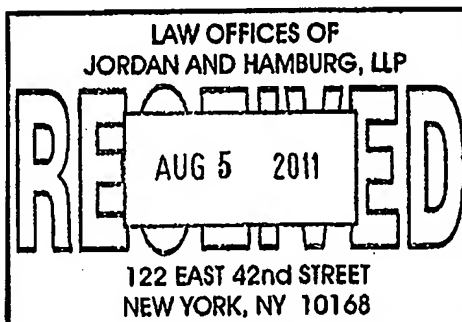
MCCLBLLAND, KIMBERLY KBIL

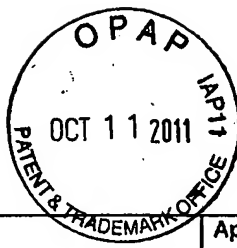
ART UNIT	PAPER NUMBER
1745	

MAIL DATE	DELIVERY MODE
08/03/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.





Office Action Summary

Application No.

12/231,970

Applicant(s)

MORIURA ET AL.

Examiner

KIMBERLY K. MCCLELLAND

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2011.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1.5, 7-8 and 11-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1.5, 7, 8 and 11-18 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 02/28/11.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/20/11 has been entered.

Response to Amendment

2. Applicant is reminded they need to explicitly point out where support for all the newly claimed features comes from as required by MPEP 714.02 and 2163.06. See 37 CFR 1.111.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rollers located side by side must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

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prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added roller configuration of "side by side" appears to contradict the originally disclosed device. Applicant has not indicated

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where support for the newly added claim language may be found. The specification does not recite this limitation. The drawings illustrate web material between the individual rollers, preventing the "side by side" relationship currently claimed.

Clarification is required.

6. Examiner also notes priority application 10/566533 filed 01/30/06 also fails to disclose the claimed roller configuration. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

7. The disclosure of the prior-filed application, Application No. 10/566533, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Appropriate correction is required.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear if the phrase, "side by side" indicates direct contact between the rollers, as argued in applicant's response filed 11/12/10. Applicant

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has not indicated where support for the newly added roller configuration may be found. The drawings do not illustrate rollers in contact, but instead illustrate rollers separated by a gap corresponding to web material. It is unclear how the base sheet powder material, and covering sheet may be transported through an apparatus with rollers in direct contact. Clarification is required. For examination purposes, examiner notes the term "side by side" is treated as equivalent to the term "adjacent".

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 5, 12, and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,994,053 to Lang in view of International Patent Application Publication No. WO 03/000163 as cited in U.S. Patent NO. 7,241,358 to Gerlach and U.S. Patent No. 4,720,321 to Smith.

12. With respect to claim 1, Lang discloses an apparatus for making a composite article, including a receiving and transferring roller (i.e. Initial guide roller) that shifts the base sheet (12) with the base sheet being held on the roller face thereof, a temporary receiving roller (14) that transfers the powder particle layer (18) onto the base sheet, while shifting the powder particle layer, with the powder particle layer being held on the roller face thereof; and a contact-bond fixing roller (22) that bonds the base sheet, the

powder particle layer and the covering sheet (20) into an integral form, while shifting the covering sheet with the covering sheet being held on the roller face thereof; wherein concave grooves which receive the powder particle layer and shift the powder particle layer being held thereon in a layer form are formed on the roller face of the temporary receiving roller (see Figure 1). Lang does not specifically disclose the receiving and transferring roller is adjacent to both the temporary receiving roller and the contact-bond fixing roller, an arc-shaped guide member for holding the powder particle layer is installed in a manner so as to face the roller face of the temporary receiving roller, or a press contact roller, which presses the covering sheet to be in contact with the base sheet on the receiving and transferring roller, being located adjacent the receiving and transferring roller, and being installed upstream from the contact-bond fixing roller.

13. Gerlach discloses a device for producing laminates, including the receiving and transferring roller (53) is adjacent to both the temporary receiving roller (57) and the contact-bond fixing roller (61b; See Figure 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the roller arrangement taught by Gerlach with the device of Lang. The motivation would have been to ensure uniform powder application (column 11, lines 46-56). Gerlach also discloses a device for producing laminates, including a press contact roller (61 (a)), which presses the covering sheet to be in contact with the base sheet on the receiving and transferring roller (53), being located adjacent the receiving and transferring roller, and being installed upstream from the contact-bond fixing roller (61 (b); See Figure 6). It would have been obvious to one of ordinary skill in the art at the time the invention

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was made to combine the roller arrangement taught by Gerlach with the device of Lang. The motivation would have been to ensure uniform powder application (column 11, lines 46-56).

14. Smith discloses an apparatus for making pads, including an arc-shaped guide (126) member for holding the material layer is installed in a manner so as to face the roller face of the temporary receiving roller (Figure 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the arc-shaped guide taught by Smith with the temporary receiving roller in the device of Lang. The motivation would have been to allow for adjustment of particle material applied (column 6, line 62-column 7, line 4).

15. The examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP § 2114. The claim limitations "that shifts the base sheet with the base sheet being held on the roller lace thereof", "that transfers the powder particle

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layer onto the base sheet, while shifting the powder particle layer, with the powder particle layer being held on the roller face thereof", and "that bonds the base sheet, the powder particle layer and the covering sheet into an integral form, while shifting the covering sheet with the covering sheet being held on the roller face thereof" are found to be functional language.

16. As to claim 5, Lang discloses at least one of the contact-bond fixing roller (172) and the receiving and transferring roller is a heat roller (column 5, lines 50-55; See Figure 13).

17. As to claim 12, Lang discloses a box (i.e. hopper) that supplies powder particles to the concave grooves being placed above the temporary receiving roller a scraping member (i.e. doctor blade) that scrapes off an excess portion of the powder particles beyond the capacity of each of the concave grooves, being attached to a wall of the box on the downstream side in the rotation direction of the temporary receiving roller (Figure 13).

18. As to claim 15, Lang does not specifically disclose the gap between the roller face of the temporary receiving roller and the guide member is 1 mm or less.

19. Smith discloses an apparatus for making pads, including an adjustable arc-shaped guide (126) capable of operating such that the gap between the roller face of the temporary receiving roller and the guide member is 1 mm or less (Figure 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the arc-shaped guide taught by Smith with the temporary receiving

roller in the device of Lang. The motivation would have been to allow for adjustment of particle material applied (column 6, line 62-column 7, line 4).

20. As to claim 16, Lang does not specifically disclose the gap between the roller face of the temporary receiving roller and the guide member is 0.2 mm or less.

21. Smith discloses an apparatus for making pads, including an adjustable arc-shaped guide (126) capable of operating such that the gap between the roller face of the temporary receiving roller and the guide member is 0.2 mm or less (Figure 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the arc-shaped guide taught by Smith with the temporary receiving roller in the device of Lang. The motivation would have been to allow for adjustment of particle material applied (column 6, line 62-column 7, line 4).

22. As to claim 17, Lang does not specifically disclose the roller face of the receiving and transferring roller faces both roller faces of the temporary receiving roller and the contact-bond fixing roller.

23. Gerlach discloses a device for producing laminates, including the roller face of the receiving and transferring roller (53) faces both roller faces of the temporary receiving roller (57) and the contact-bond fixing roller (61; See Figure 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the roller arrangement taught by Gerlach with the device of Lang. The motivation would have been to ensure uniform powder application (column 11, lines 46-56).

24. As to claim 18, Lang does not specifically disclose the temporary receiving roller is located side by side with the receiving and transferring roller, the contact-bond fixing roller is located side by side with the receiving and transferring roller, and the press contact roller is located side by side with the receiving and transferring roller.

25. Gerlach discloses a device for producing laminates, including the temporary receiving roller (57) is located side by side with the receiving and transferring roller (53), the contact-bond fixing roller (61b) is located side by side with the receiving and transferring roller (53), and the press contact roller (61a) is located side by side with the receiving and transferring roller (63; See Figure 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the roller arrangement taught by Gerlach with the device of Lang. The motivation would have been to ensure uniform powder application (column 11, lines 46-56).

26. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,994,053 to Lang in view of International Patent Application Publication No. WO 03/000163 as cited in U.S. Patent NO. 7,241,358 to Gerlach and U.S. Patent No. 4,720,321 to Smith as applied to claims 1, 5, 12, and 15-18 above, and further in view of U.S. Patent No. 5,868,895 to Inoue.

27. With respect to claim 7, Lang does not specifically disclose an arc-shaped protective plate member which prevents the powder particle layer from flowing being located close to the roller face of the receiving and transferring roller.

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28. Inoue discloses an apparatus for bonding including an arc-shaped protective plate member (11) which prevents the powder particle layer from flowing being located close to the roller face of the receiving and transferring roller (Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the arc plate taught by Inoue with the apparatus of Lang. The motivation would have been to allow for covering of the bonding site for prevention of contaminants.

29. As to claim 8, Lang does not specifically disclose the distance between the roller face of the receiving and transferring roller and the protective plate member is set in a range from 0.5 to 5 mm.

30. Inoue discloses an apparatus for bonding including the distance between the roller face of the receiving and transferring roller and the protective plate member (11) is set in a range from 0.5 to 5 mm (column 9, lines 10-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the arc plate taught by Inoue with the apparatus of Lang. The motivation would have been to allow for covering of the bonding site for prevention of contaminants.

31. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,994,053 to Lang in view of International Patent Application Publication No. WO 03/000163 as cited in U.S. Patent NO. 7,241,358 to Gerlach and U.S. Patent No. 4,720,321 to Smith as applied to claims 1, 5, 12, and 15-18 above, and further in view of U.S. Patent Application Publication No. 2003/0201052 to Koslow.

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32. With respect to claim 11, Lang does not specifically disclose a hydraulic or an air-pressure cylinder supporting the press contact roller.

33. Koslow discloses an apparatus for producing composite material, including a hydraulic or an air-pressure cylinder supporting the press contact roller (260; paragraph 0020). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the air cylinder taught by Koslow with the apparatus of Lang. The motivation would have been to maintain the desired pressure during lamination (paragraph 0020).

34. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,994,053 to Lang in view of International Patent Application Publication No. WO 03/000163 as cited in U.S. Patent NO. 7,241,358 to Gerlach and U.S. Patent No. 4,720,321 to Smith as applied to claims 1, 5, 12, and 15-18 above, and further in view of U.S. Patent No. 4,507,173 to Klowak et al.

35. As to claim 13, Lang does not specifically disclose the distance between the roller face of the temporary receiving roller and the roller face of the receiving and transferring roller is 3 mm or less.

36. Klowak et al. discloses an apparatus for making fibrous products, including it is known in the art of printing to provide engraved transfer rollers (i.e. gravure-impression) with a nip of 3 mm or less during material transfer (column 12, lines 53-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the nip distance taught by Klowak et al. with the temporary receiving roller in

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the device of Lang. The motivation would have been to ensure material transfer from the roller onto the web material.

37. As to claim 14, Lang does not specifically disclose the distance between the roller face of the temporary receiving roller and the roller face of the receiving and transferring roller is 1 mm or less.

38. Klowak et al. discloses an apparatus for making fibrous products, including it is known in the art of printing to provide engraved transfer rollers (i.e. gravure-impression) with a nip of 1 mm or less during material transfer (column 12, lines 53-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the nip distance taught by Klowak et al. with the temporary receiving roller in the device of Lang. The motivation would have been to ensure material transfer from the roller onto the web material.

Response to Arguments

39. Applicant's arguments with respect to claims 1, 5-8, and 11-18 have been considered but are moot in view of the new ground(s) of rejection. Applicant's remaining pertinent arguments are addressed below:

40. As to applicant's argument that contact roller (61b) of Gerlach is not adjacent to application drum 53, this argument is not persuasive. As previously noted, the term "adjacent" has a broader meaning than side by side. *Ex parte Appledorn et al.*, 159 USPQ 791. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., a contact bond fixing roller in direct contact with the receiving and transferring roller) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

41. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). With respect to applicant's arguments regarding the deficiencies of Gerlach, examiner notes Lang, not Gerlach, is the primary reference of the current prior art rejections. Applicant has not addressed the disclosure of Lang with regard to the function of the separate rollers. Therefore, these arguments are not persuasive.

42. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., contact bond fixing roller in contact with a base sheet on the receiving and transferring roller) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

43. In response to applicant's argument that Smith does not disclose a roller with concave grooves, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the

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references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

44. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As to applicant's argument that Lang does not disclose the claimed arc guide member, examiner agrees. However, secondary reference Smith, not Lang is relied upon to teach an arc-shaped guide member. Smith specifically discloses one of ordinary skill in the art would be motivated to combine the arc shaped guide with a powder deposition roller to allow for adjustment of the particle material applied. Therefore, the combination is found to meet the claimed arc shaped guide member and provide the necessary motivation to one of ordinary skill in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMBERLY K. MCCLELLAND whose telephone number is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KIMBERLY K MCCLELLAND/
Primary Examiner, Art Unit 1745

KKM